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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,550	09/09/2003	Alan Weiss	MCA-623 US	3075
25182	7590	10/31/2005	EXAMINER	
MILLIPORE CORPORATION 290 CONCORD ROAD BILLERICA, MA 01821			MENON, KRISHNAN S	
			ART UNIT	PAPER NUMBER
			1723	
DATE MAILED: 10/31/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/659,550

Applicant(s)

WEISS ET AL.

Examiner

Krishnan S. Menon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Claims 1-19 are pending as originally filed

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5-13 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: Claim 1 from which the instant claims depend recites an evaporation control device which is situated between the bottom surface of the filtration plate and the top surface of the collection plate. Instant claims recite the evaporation control device as a cover having a skirt which covers the entire thickness of the filtration plate and at least part of the thickness of the collection plate. The evaporation device as recited in claim 1 and having a skirt that extends downwards would not cover the entire thickness of the filtration plate, since it is situated below the filtration plate.

For examination, it is assumed that the evaporation control device of the instant claims is a different, additional, element than the evaporation control device recited in claim 1, and is identified as a "cover" covering the top of the filtration plate.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Root (US 5,650,323).

**Clarification:** All the claims in this application are directed to “a system for reducing evaporation in a multiwell filtration plate”. However, the claims then also recite the limitations for the multiwell plate and the collection plate.

Applicant defines the evaporation control device in page 2 of the specification as:

*“In one embodiment, it is simply a sheet material that forms a gasket between the two plates to minimize the evaporation at the intersection of the two plates. In another embodiment, it is the sheet material between the two plates and a cover over the top plate. In a third embodiment, it is a cover which covers the top surface of the upper plate and has a skid that extends downward from the top of the plate system to at least a point below the filter plate/collection plate interface.” [Italics added]*

Since the definition of the evaporation control device in the specification does not include the filtration and collection plates, it is assumed that the applicant intended to claim the combination, the assembly of the multiwell

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filtration plate having the filtration plate and the collection plate, with either or both of the evaporation control gasket and the evaporation control cover.

Root teaches an evaporation control system having a filter plate (58), a collection plate (40) and an interface between the filter plate and the collection plate (the interface formed between the two when joined in assembly); the filter plate and the collection plate register with each other, and the cover plate for evaporation control (see fig 14, cover is not numbered; col 5 lines 35-39; abstract) as claimed – see fig 14.

2. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Kedar et al (US 6,083,761).

Kedar teaches a multiwell plate system having filtration plate with a series of wells (52-figure 9,9A and 10) having filters (58 are capillary holes which are like filters; see column 1 lines 43-50 for the teaching of filters; column 9 lines 3-42 for capillary holes in place of mesh filters; also column 5 lines 27-40), collection plate (62) having wells (64), and an evaporation control device (66) between the filtration plate and the collection plate (column 16 lines 8-27). The evaporation control device (66) is a sheet material with a series of holes which register with the filter plate and the collection plate, with the holes of the evaporation control device slightly larger than the holes in the plates as claimed.

3. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Root et al (US 4,948,564).

Root'564 teaches a filtration plate (18-figure 4) with a filter (34-figure 3) in the bottom of each well, a collection plate (76 figure 4) with wells (78), and an evaporation control device (64) having holes (92) which register with the wells of the filter plate and the collection plate, a hole for each of the wells, as claimed. See column 3 lines 3-32.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Root'323.

Root'323 teaches all the limitations of claim 14. Instant claims add the further limitation of the extension of the skirt of the cover, or evaporation control device, down the thickness of the collection plate, which is not specifically taught by the reference, and is shown as part of the way down the thickness of the collection plate in figure 14. However, this distance to which the skirt of the cover need to extend would be within the purview of one of ordinary skill in the art to design, to obtain sufficient closure with the cover. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative

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dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. IN the instant case, the depth to which the skirt covers the thickness of the collection plate would be only a matter of differing dimensions, and the prior art structure would not perform any differently.

5. Claims 5-13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Root'564 as applied to claim 1 in paragraph 3 above and further in view of Root'323.

Instant claims, including independent claim 19, recite the filter plate, the well plate, the evaporation control device between the filter plate and the well plate and the cover on the filter plate, and differ from the teaching of Root'564 in the recitation of the "cover" which covers the top of the filter plate, and which has a skirt that extends down to the collection plate in the bottom. Root'564 teaches a cover (202) in figure 14 and 15, but this cover does not have the skirt.

Root'323 teaches a cover with a skirt as claimed in figure 14 in a multiwell filtration plate system. It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Root'323 in the teaching of Root'564 for the cover because the cover of Root'323 would keep the system from evaporation losses, and particularly, the cover of Root'323 in figure 14 having drip rings matching each well that would maintain sterility and evaporation control. See column 4 lines 4-8 and column 5 lines 34-39 of Root'323.

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The distance to which the skirt of the cover need to extend would be within the purview of one of ordinary skill in the art to design, to obtain sufficient closure with the cover. In *Gardner v. TEC Systems, Inc.*

The additional limitations in claims 10 and 11, molded or vacuum formed is a process limitation in a product claim, and is not patentable. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re *Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

The additional limitation in claims 12 and 13, providing the score lines to trim the skirt extension is a part of the process of assembly, which is not patentable in the product or apparatus claim, since the product or apparatus as assembled would not have the part that was trimmed off. In re *Thorpe*. (See the clarification in paragraph 1, under the rejection of claim 14).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S. Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'K S Menon', written in a cursive style.

Krishnan S. Menon  
Patent Examiner  
10/26/05